

### **PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Applicant respectfully requests a Pre-Appeal Brief Review ("Request") of the claims rejected in the Final Office Action mailed December 3, 2008. This Request is submitted in accordance with the rules set forth in the Official Gazette dated July 12, 2005. The review is needed because the final rejection of Claims 2, 5, 6, 43-47, 49, and 50 under 35 U.S.C. §102(e) and Claims 3, 7, 48, and 51-53 under 35 U.S.C. §103(a) over the cited art is clearly in error.

#### **A. Claim Status**

Claims 2, 5, 6, 43-47, 49, and 50 stand finally rejected under 35 U.S.C. §102(e) as allegedly being anticipated by Graves, U.S. Patent No. 6,416,667 (hereinafter "Graves"). Claims 3, 7, 48, and 51-53 stand finally rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Graves in view of Fochler, U.S. Patent No. 3,330,303 (hereinafter "Fochler"). (Although Claims 35-42 also stand finally rejected under 35 U.S.C. §112 as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter regarded as the invention, Applicant does not request Pre-Appeal Brief Review of this rejection. Depending on the action taken on this Pre-Appeal Brief Review, Applicant intends to amend the application to overcome this rejection.)

#### **B. Reasons why the Final Rejection of Claims 2, 5, 6, 43-47, 49, and 50 as being anticipated by Graves is clearly in error**

The Examiner has not established a *prima facie* case of anticipation in rejecting the claims, since (1) Graves does not teach all of the features of the claimed invention, and (2) the Examiner has failed to show that a characteristic not disclosed in the Graves reference is inherent.

##### **B1. Graves does not teach all of the features of the claimed invention**

The Examiner bears the initial burden of establishing a *prima facie* case of anticipation by pointing out where all the claim limitations appear in a single reference. *In re Spada*, 911 F.2d 705, 709, 15 USPQ2d 1655 (Fed. Cir. 1990). In addition, a claim is anticipated only if each and every element as set forth in the claim is expressly or inherently described in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

Among other things, Graves does not disclose or suggest at least Applicant's claimed features of "female flange configured to receive a similarly sized and shaped rung element on the end of a similar second pipe section" (Claim 43); or "the first female structure being temporarily deformable

to receive the male structure, the temporary deformation being both sufficiently large to permit the insertion of the male structure but also sufficiently small to ensure that material memory returns the first female structure toward its original non-deformed configuration” (Claim 2), or corresponding limitations recited in independent Claim 50.

Graves is directed to an apparatus for rejuvenating a wastewater treatment system. In Graves, a solids settling and retention basin 21 is provided within which a wastewater treatment mechanism 50 is suspendingly supported. In rejecting the claims, the Examiner construes the middle tubular section 23 in Graves to correspond to the first piece of pipe, and lower tubular section 24 to correspond to the second piece of pipe recited in Claim 2. The Examiner also appears to construe the axial length of the tubular body 31 (see Graves, column 8, lines 6-20) as corresponding to “said exterior surface forms a generally sinusoidal pattern of alternating similarly-shaped and similarly-sized (a) rung elements and (b) valley portions” as recited in Claim 43, and corresponding limitations recited in Claims 2, 49 and 50 (see page 5 of Final Office Action dated December 3, 2008). Applicant respectfully disagrees.

Among other things, even if Graves does teach a “repeating” sinusoidal pattern of rung elements and valley portions (which Applicant respectfully submits he does not), Graves still does not disclose or in any way suggest joining female and male joint portions of pipe that are “similarly sized and shaped”. Applicant respectfully submits that instead, Graves teaches joining together sections that have dissimilar diameters (e.g., at column 8, lines 24-46: “a cylindrical wall portion 49 of each smaller valley 36 (FIG. 6) will telescopically seat within the remaining portion of the wall portion 39 of the larger valley 35 resulting in the telescopic nested supported relationship”; emphasis added). Accordingly, Graves certainly does not disclose or make obvious Applicant’s claimed *similarly sized and shaped* male and female joint portions (see Applicant’s February 3, 2009 Request for Reconsideration, pages 2 to 6).

**B2. The Examiner has failed to show that a characteristic not disclosed in the Graves reference is inherent**

Rejections based on inherency must provide extrinsic evidence which makes clear that the missing descriptive matter is necessarily present in the thing described in the alleged anticipatory reference and that it would be recognized by a person of ordinary skill in the art. *Atlas Power Co. v. IRECO, Inc.*, 190 F.3d 1342, 1349, 51 USPQ 1943, 1948 (Fed. Cir. 1990). In the present case, the Examiner has failed to provide (and indeed cannot provide) any such *prima facie* showing of

inherency to support the anticipation rejection. Specifically, it would in fact be contrary to common sense and "inherency" to try to make two *similarly sized and shaped* male and female joint portions interfit as claimed by Applicant--to do so requires deforming one of them to allow the claimed engagement.

In particular, the Examiner cites Graves as disclosing Applicant's claimed "first female structure being temporarily deformable to receive the male structure, the temporary deformation being both sufficiently large to permit the insertion of the male structure but also sufficiently small to ensure that material memory returns the first female structure toward its original non-deformed configuration with sufficient compressive force to grip the male structure and to help prevent its inadvertent removal from engagement with the first female structure". In support of that position, the Examiner states that since the female structure of Graves is formed from a polymeric/copolymeric material which inherently has the ability to temporarily deform (see Final Office Action dated December 3, 2008 at page 11).

Applicant respectfully disagrees. The fact that Graves' material could be deformed is not sufficient to meet the requirement that such deformation be inherent in practicing Graves' teachings. Indeed, at column 6, lines 43-47, Graves discloses a solids settling and retention basin 21 which is molded from polymeric/copolymeric synthetic plastic material. Nothing in the Graves patent teaches or requires that the basin material have any "deformable" material memory properties (such as claimed by Applicant). Said another way, since Graves teaches joining together dissimilar portions of tubing, anyone practicing Graves' teaching has no motivation or need to provide a material with any material memory and temporary deformation properties--Graves' smaller valley portions 36 readily "telescopically seat" within the larger valley portions 35 without having to deform any of the portions (see Applicant's February 3, 2009 Request for Reconsideration at pages 6 to 7).

**C. Reasons why the Final Rejection of Claims 3, 7, 48, and 51-53 as being unpatentable over Graves in view of Fochler is clearly in error**

Neither Graves, Fochler nor any permissible combination of them teaches all of the features of the claimed invention, and in any case the Examiner has failed to explain why one of ordinary skill in the art would be led to combine the teachings of Graves and Fochler.

**C1. The references do not teach all of the features of the claimed invention**

The Examiner bears the burden of establishing a *prima facie* case of obviousness based on the prior art when rejecting the claims under 35 U.S.C. 103. *In re Fritch*, 972 F.2d 1260, 23

U.S.P.Q.2d 1780 (Fed. Cir. 1992). In addition, all limitations of the claimed invention must be considered when determining patentability. *In re Lowry*, 32 F.3d 1579, 1582, 32 U.S.P.Q.2d 1031, 1034 (Fed. Cir. 1994). Therefore, no *prima facie* obviousness rejection can be established if the proposed combination does not teach all of the features of the claimed invention.

In the present case, neither Graves nor Fochler nor their combination discloses or suggests at least the claimed features of joining similarly sized and shaped joint portions, and material memory and temporary deformation properties. As discussed above, Graves does not disclose those elements as recited in Applicant's independent Claims 2, 43; or 50. Fochler is cited by the Examiner as disclosing providing an internal non-corrugated liner element, and does not supply the above deficiencies in Graves.

**C2. The Examiner has failed to provide articulated reasons as to why one of ordinary skill in the art would be led to combine the teachings of the references**

Rejections based on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. *Teleflex Inc. v. KSR Int'l Co.*, 550 U.S. at 1,82 USPQ2d at 1396 (2007). In the present case, and independently of the foregoing, the Examiner fails to state a *prima facie* case of obviousness since the Examiner fails to provide articulated reasons as to why one of ordinary skill in the art would be led to combine the teachings of the references. Although the Examiner cites Fochler as disclosing “an internal non-corrugated liner element to support the surrounding outer corrugated tube” and asserts that it would be obvious to combine the references since Fochler relates to composite tubing structures (see Final Office Action dated December 3, 2008, page 7), Applicant respectfully disagrees. Pertinent portions of Graves include:

[Paragraph at column 9, line 52] ...the intermediate or middle tubular section 23, ... an inwardly projecting rib 95 (FIG. 4) having an innermost cylindrical wall portion 96 of a diameter less than the diameter of the ribs 33, 34 and an upper substantially horizontal wall portion 97. The rib 95 projects inwardly substantially beyond the inward projection of any of the ribs 33, 34, and this allows the wastewater treatment mechanism 50 to be inserted into and withdrawn from the solids settling and retention basin 21 through the open upper end (unnumbered) upon the removal of the safety/service cover 45 and a separately fabricated heavy duty access cover 46. Since the flange 75 (FIG. 2) of the filter media body 70 of the wastewater treatment mechanism 50 has a diameter substantially greater than the opening defined by the cylindrical wall portion 96 of the rib 95, the flange 75 is underlyingly supported by the horizontal wall portion 97 of the rib 95 of the tubular section 23.

Clearly, the purpose of Graves internally projecting ribs is to suspendingly support the wastewater treatment mechanism within the solids settling and retention chamber of the solids settling and retention basin. In addition, Graves fails to teach or suggest providing a liner element in his solids settling and retention basin. Accordingly, one of ordinary skill in the art would have not been motivated to combine Fochler with Graves to provide an internal non-corrugated liner element as proposed by the Examiner since Graves teaches only to provide internally projecting (i.e., corrugated) ribs. Apparently, Graves purposely does not provide a liner element since Graves' internally projecting ribs appear to be an essential component of his solids settling and retention basin. In fact, combining Fochler's liner with Graves apparently would be *contrary* to Graves, as it would defeat (or at least reduce) the effectiveness of the setting/retention function of Graves' internal ribs.

In addition, the Examiner cites Graves in view of Fochler as disclosing “the confronting ends of the respective internal non-corrugated liner elements of the respective pieces of pipe generally form a butt joint with each other, the butt joint providing a substantially smooth interior transition surface longitudinally between the respective pipe elements” and “a sealing gasket element between the confronting ends of the respective internal non-corrugated liner elements of the respective pieces of pipe”. Applicant respectfully submits that since the Examiner failed to provide articulated reasoning for combining Graves with Fochler to provide an internal non-corrugated liner, there is no motivation to combine Graves with Fochler to provide additional features of an internal non-corrugated liner.

Further, the Examiner cites Fochler as disclosing “an adhesive material acting between confronting surfaces of said first and second pieces of pipe”, again with no articulated reasoning or motivation to combine the references.

#### **D. Conclusion**

For at least the reasons indicated above, the claims should be allowable over the cited art, and Applicant respectfully requests that the Pre-Appeal Brief Panel withdraw the rejections.

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/J. Mark Holland/

J. Mark Holland, Reg. No. 32,416

Alison L. Vass, Reg. No. 63,078

PTO Customer Number 21,259

JMH:alv